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jgardner@oblon.com

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3 RECORD OF ORAL HEARING
4 UNITED STATES PATENT AND TRADEMARK OFFICE
5

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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9

10 Ex parte ALINE ABERGEL
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13 Appeal 2008-3779
14 Application 10/698,415
15 Technology Center 3700
16

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18 Oral Hearing Held: February 12, 2009
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22 Before WILLIAM F. PATE, III, JOHN C. KERINS, and STEVEN D.A.
23 McCARTHY, Administrative Patent Judges
24

25
26 ON BEHALF OF THE APPELLANT:
27

28
29 CHRISTOPHER A. BULLARD, ESQUIRE
30 Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
31 1940 Duke Street
32 Alexandria, Virginia 22314
33

34 The above-entitled matter came to be heard on Thursday, February 12,
35 2009, commencing at 1:15 p.m., at the United States Patent and Trademark
36 Office, 600 Dulany Street, Alexandria, Virginia, before Laurel P. Platt,
37 Notary Public.

PROCEEDINGS

THE CLERK: Good afternoon. Calendar number 52. Mr. Bullard.

JUDGE PATE: Mr. Bullard, good to see you this afternoon.

MR. BULLARD: Good afternoon, Your Honors.

JUDGE PATE: We've had a chance to go over this case beforehand, so we're up on the technology, and we'd like to hear the arguments concerning patentability.

MR. BULLARD: Well, good afternoon, Your Honors. As you know, my name is Christopher Bullard, and I represent the Appellant in Appeal Number 2008-3779.

There are two independent claims that are -- the rejection of these independent claims is being appealed in this case. They're independent claim 1 and independent claim 16.

Independent claim 1 stands rejected under 35 USC § 103(a) as obvious over Kelly and in view of Coburn and Destanque. And claim 16 is rejected as obvious over Kelly, Guiard and Parrotta.

Now, each of these independent claims includes a combination of features that is not found in the combined teaching of all the cited references.

If the Board doesn't have any objection, I will start with claim 1.

JUDGE PATE: That would be fine. Thank you.

MR. BULLARD: In claim 1, a device for packaging a product, which is best viewed as an example in Figure 4 of the present application, includes a support in a lid.

Claim 1 requires that the device for packaging the product includes a

1 sticker forming a mirror that is adhesively bonded to both the face of the lid
2 and the face of the support, but more importantly, claim 1 also requires that
3 a sticker forming the mirror articulates the lid to the support.

4 So claim 1 requires a combination of features where you have a mirror
5 that is adhered to both the face of the lid and a support and functions to
6 articulate the lid to the support.

7 Now, each of these cited references, Kelly, Coburn and Destanque,
8 describe packages that include individual units on individual surfaces and
9 independently recite hinges that articulate those two surfaces to each other.
10 So there's no teaching or suggestion for the combination of elements that's
11 recited in claim 1.

12 So if the Board doesn't have any further questions on that, I think that
13 element is entirely absent.

14 With respect to claim 16, claim 16 --

15 JUDGE McCARTHY: Counsel, actually, I'd like to go back to claim
16 1. Is there any particular reason why the mirror would have to be adhesively
17 bonded onto the inner surfaces of the lid and the body, or is it possible that
18 the mirror could be adhesively bonded to the outer surfaces?

19 MR. BULLARD: As recited in claim 1, there's no requirement for
20 which surface it can be bonded to. Although the example in figure 4
21 illustrates it being bonded onto the interior surface, it could just as easily be
22 bonded onto the exterior surface.

23 However, even if the claim were interpreted as requiring that it be
24 bonded on either the interior or exterior surface, there's still no teaching in
25 the cited references of a mirror that is bonded to two surfaces and performs
26 the function of articulating the lid to the support.

1 JUDGE McCARTHY: Wouldn't it be a matter of simple substitution
2 just to substitute a sticker or an adhesive material that has a mirrored surface
3 for the paper board that's disclosed in the main reference?

4 MR. BULLARD: Well, whether that be a case of simple substitution,
5 there's no reference that describes such a mirrored surface as a sticker that
6 would be suitable for that function.

7 JUDGE McCARTHY: But under KSR, do we need a reference that
8 teaches that?

9 MR. BULLARD: We do need a reference, Your Honor. We need a
10 reference to show the structural elements that are present.

11 While the elements that are present can be modified in view of one's
12 ordinary skill and knowledge, there would have to be a clearly articulated,
13 supported, rational basis for performing that modification.

14 In the present case, for example, the Examiner has pointed to the
15 Coburn reference and said that the Coburn reference describes a mirror that
16 is in the form of a sticker.

17 Now, the Coburn reference illustrates an alternative type of mirror to
18 the type of mirrors that are illustrated in Kelly and Destanque.

19 The purpose of the mirror in Coburn is to provide an undistorted
20 mirror. It is a layered structure that is supported on a piece of plastic that
21 has a layer of foam that removes the distortions in the mirror. However,
22 Coburn describes specifically that this is intended so that the mirror can
23 remain flat and stationary.

24 Therefore, with the evidence that we have before us on the record,
25 there is no teaching that would say that that would be suitable to also
26 perform the function of being a mirror that would articulate a lid to the

1 support.

2 Quite the opposite. It would say that this is an alternative structure,
3 and a simple substitution would suggest to simply substitute the mirror in
4 Coburn as an alternative to the single mirrors on single surfaces that are
5 present in Kelly and Destanque.

6 JUDGE PATE: Can I ask you, how are we supposed to construe this
7 claim term sticker?

8 MR. BULLARD: Well, the sticker -- and actually, the specification
9 provides a little bit of guidance as to how we can determine the mirror
10 sticker.

11 So for example, it says a sticker forming a mirror may be formed, for
12 example, by one or more layers of material selected from thermoplastic
13 material, in particular, polyolefins or polyesters, and aluminum and a layer
14 of paint forming the mirror. But more importantly, Your Honor, it has to be
15 interpreted in the context with which it's used in the claim.

16 The sticker forming in the mirror has to be capable of not only being a
17 mirror-reflective surface but of performing the function of articulating the
18 lid to the support. So merely having a surface that has an adhesive on it isn't
19 enough.

20 In some contexts it may be proper to say a sticker is something that
21 includes an adhesive. But in the context of claim 1, in the context of the
22 disclosure in the specification, it would not be appropriate to say that a
23 mirror of layered flat surface that has an adhesive on it would meet the
24 limitations of claim 1, the mirror sticker recited in claim 1.

25 JUDGE PATE: Okay. If it was a layer of adhesive that was tacky,
26 that would be a sticker?

1 MR. BULLARD: Potentially, but it may not necessarily be the sticker
2 as recited in claim 1.

3 Again, Your Honor, the sticker as recited in claim 1 is a sticker that
4 forms a mirror that articulates the lid to the support. Therefore, it needs to
5 be capable of performing that function, and it needs to be capable of
6 articulating the lid to the support, and it wouldn't merely be a layer that had a
7 tacky surface on it.

8 JUDGE PATE: So you are construing articulated to mean a folded
9 joint?

10 MR. BULLARD: I'm construing articulated to mean that --

11 JUDGE PATE: It's pretty broad.

12 MR. BULLARD: What's that?

13 JUDGE PATE: The word is pretty broad, isn't it? Articulated, like
14 my elbow articulates my forearm to my --

15 MR. BULLARD: Well, I think you bring up a good point, Your
16 Honor, that articulate is a term that means that two parts can be able to move
17 relative to each other.

18 In the context of this device, the lid is articulated to the base. The lid
19 can move relative to the base. It provides, if you will, a hinge.

20 In each one of the cited references they have separately described
21 hinge elements. None of the mirror elements are used as a hinge element.
22 They each individually describe their own hinge element.

23 For example, in Kelly there is a hinge 24, the cardboard, but
24 separately described is a mirror. In Coburn, there is hinge 22 that's separate
25 and distinct from the mirror 12. In Destanque, for example, there's a film
26 hinge 27A, 27B, which Destanque describes as potentially molded as a

1 single piece with a lid.

2 So again, the mirrors in Destanque 38A and 38B are separate and
3 distinct, and they're individual items that are individual lids. They're not
4 items that span between a lid and support and provide the articulation from
5 the lid to the support.

6 JUDGE PATE: Okay. Go ahead.

7 MR. BULLARD: If you have no more questions on 1, then we can go
8 to 16. 16 also recites a device for patenting a product. In 16 there is also a
9 support and a lid.

10 However, 16 further requires that the support have a cavity that opens
11 on two faces. The cavity contains a product.

12 More importantly, in 16, and what is absent from the cited references,
13 is an adhesive sheet that is fixable to the base of the lid and the base of the
14 support. The adhesive sheet articulates the lid to the support, but essentially
15 the adhesive sheet directly faces the product that is in the cavity.

16 Now, in each of the cited references there is something between that
17 which closes the cavity or is directly in contact with the cavity and the
18 product and the thing that articulates the lid to the support.

19 JUDGE McCARTHY: Counsel, is the term "directly facing" defined
20 anywhere in the specification?

21 MR. BULLARD: I don't know off the top of my head whether the
22 exact term "directly facing" is defined in the specification, but in the context
23 of the specification there is a description of utility, of having the adhesive
24 sheet in direct contact with the product.

25 In particular, one of the purposes and advantages of this particular
26 product is as a sample, as a sample product. And one of the advantages of a

1 sample product is when somebody opens up that sample product, they don't
2 want to see a mess.

3 So the way this product works is you have a flat piece. It's the flat
4 support that has a through-hole punched through it. And then the top, the
5 part that is going to be viewed by the user, is sealed first in the cavity. It's
6 flipped over. Then the correct amount of powder or compact or liquid can
7 be put in on the back side. Then you don't have any mess on the back side.

8 But additionally, this adhesive sheet that's recited in claim 16 adheres
9 to the back of that, directly to that, and serves to help hold that product
10 directly in there.

11 One of the advantages of having the product directly in the cavity, as
12 described in the specification, is that you no longer have to have the type of
13 tray that's described in Kelly or the type of tray that's described in Guiard,
14 for example. So it can be less bulky.

15 But the advantage of this flip-over-type arrangement is that it's small,
16 compact. Someone who opens up a magazine can, for example, see
17 something that presents itself as a very similar type product to a compact
18 product, and when they open it up, there won't be any of the stray product on
19 the top.

20 JUDGE KERINS: Counsel, you mentioned the tray that is disclosed
21 in Guiard, possibly in Kelly. There was an issue joined between the
22 Appellant and the Examiner as to whether the product could consist of the
23 cosmetic product plus that pan, I think it might be called. Why is it
24 unreasonable to interpret product as both the cosmetic material and the pan?

25 MR. BULLARD: Well, there's two points there, Your Honor. The
26 first point is the Examiner looked at Guiard and said, well, this is separable

1 from the tray. But really, when you look, when someone is presented with
2 the product in Guiard, there is both the tray 18 and the pasty material 20, but
3 the tray 18 is fixed to the holder 11.

4 So when one is presented with it, the product to the user, the product
5 to the one that's going to use it is going to be that pasty material 20. It's not
6 going to be the tray itself, no more than the whole device itself would be
7 considered the product that's contained in the tray itself.

8 To say that the tray and the product are the product is to confuse
9 whether the product is the product itself or what holds the product. And in
10 addition --

11 JUDGE PATE: Actually, the word product just means something
12 that's produced. If we're to supply a reasonable interpretation of product, the
13 spec says cosmetic product, but the claim doesn't say anything about
14 cosmetic product. "Product" is pretty broad term.

15 MR. BULLARD: I agree that the term "product" is a pretty broad
16 term, but even the Examiner recognizes the need to apply the Parrotta
17 reference. And in the Parrotta reference, again, there is an interposing layer,
18 the barrier layer 36 between that which articulates the lid to the base, in that
19 case a paper product, and the product itself.

20 JUDGE KERINS: Counsel, wasn't that an alternative contention
21 made by the Examiner? To the extent that the Board might consider the pan
22 to not be part of the product, the Examiner brought in a tertiary reference.

23 MR. BULLARD: Well, if that's the case, Your Honor, even a tertiary
24 reference doesn't cure it.

25 JUDGE KERINS: I understand. I'm going back to the secondary
26 grounds.

1 MR. BULLARD: Well, again, I would say that the pasty material 20
2 is the product, and 18 is that which holds the product. And that by --

3 JUDGE PATE: Do you want us to read pasty material into this
4 claim?

5 MR. BULLARD: No, Your Honor, I'm not asking you to read pasty
6 material into this claim.

7 What I'm saying is that the distributing of product samples for
8 promotional purposes, that's what the abstract of the art says. The product
9 sample in this case is the pasty material. The product sample is not the pasty
10 material inside the tray.

11 In the context of the claim, it recites -- claim 16 recites that, "cavity
12 contains a product having the first side adjacent to the first opening and the
13 second side adjacent to the second opening." It is that product that is that
14 adhesive sheet which covers the second opening, directly faces the second
15 side of said product contained in the cavity.

16 Again, I would say the product distribution in Guiard is not the tray 18
17 with pasty material 20. The product is the pasty material 20. That is our
18 position with respect to that.

19 I would say that there is a tray that's interposed between that pasty
20 material. And Kelly has the tray that's interposed between the material as
21 well.

22 None of them recognizes the advantages here. The key feature here is
23 that each one of these references is directed to different purposes and
24 advantages than the present invention.

25 The present invention is directed to this small, clean and useful
26 package for packaging a sample product, but a package for packaging a

1 sample product that is a lot cleaner and easier to manufacture, as well it
2 doesn't have the bulk that all these trays require. When you have a tray --

3 JUDGE McCARTHY: Counsel, is the product recited in the last part
4 of the claim part of the combination that you're claiming?

5 MR. BULLARD: Yes, it is.

6 JUDGE McCARTHY: So this would have to be the package in
7 combination with the product in order to meet this claim.

8 MR. BULLARD: That's right, because claim 16 recites wherein said
9 cavity contained the product having the first side adjacent to said first
10 opening, to said second opening.

11 In fact, that is the idea that the package includes the product. And one
12 of the advantages, like I say, is that the compacted product can be directly
13 facing the adhesive sheet. The adhesive sheet adheres it, but it also performs
14 the function of holding the lid to the base.

15 When you use a tray, for example, you can separately fill the product
16 into the tray, but then you have to locate the tray in the hole that's been
17 placed.

18 You may have too much product. You may have lost product. You
19 have this problem of this stray product, which in the sample your first
20 opportunity to present the user with your new product can be detrimental.
21 And so they have approached it in a different way.

22 The Parrotta reference is the closest reference actually in that it's
23 similar to what this type of device is. The Parrotta reference is vastly more
24 complex. It's a folded sheet of paper. It requires the barrier layer. It
25 requires the separation area.

26 By contrast, this simple design provides for easier manufacture. It

1 provides for a cleaner overall presentation, and it provides for less loss. You
2 don't have to have the manufacturing tolerances when the tray meets into the
3 hole.

4 So with that, I would say that none of the cited references has the
5 combination of an adhesive sheet that's both on the lid and the base and that
6 directly faces the product in the cavity.

7 JUDGE KERINS: Counsel, on that point, doesn't the Kelly reference
8 suggest that that's a possibility?

9 MR. BULLARD: Where does it suggest that, Your Honor?

10 JUDGE KERINS: I'm reading page 3, paragraph 27. It refers to the
11 cosmetic material -- I'm sorry -- and pan being forced into the cavity and
12 may be adhesively bonded to the base and/or the hinge base section, which
13 means the pan there would be -- that it could be easily bonded to the hinge
14 base section?

15 MR. BULLARD: Again, Your Honor, there would be the pan in
16 between the product and the adhesive base section. So when you have a
17 pan, the pan is still in between the product and the adhesive base section.

18 So if you interpret the hinge to be the adhesive sheet -- that element
19 24 would be the adhesive sheet -- then in that case, Your Honor, the pan
20 would be interposed between it. It would not directly face it. So it would
21 still not be all the elements of the claim.

22 If you have no further questions, Your Honor, regarding claims 1 or
23 16, I would respectfully request that the rejections be overturned.

24 JUDGE KERINS: I have no further questions.

25 JUDGE PATE: I have no further questions either. We are going to
26 take this case under advisement.

- 1 MR. BULLARD: Thank you, Your Honor.
2 JUDGE PATE: Do you have a business card for the court reporter?
3 MR. BULLARD: Yes, I do, Your Honor.
4 Thank you, Your Honor.
5 (Whereupon, the proceedings at 1:32 p.m. were concluded.)